



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,759	05/02/2001	Mark J. Hall	HANBEV.002RA	6043

20995 7590 05/19/2003

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

GIBSON, ROBERT W

ART UNIT PAPER NUMBER

3634

DATE MAILED: 05/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09847,759

Applicant(s)

Hall

Examiner

Gibson

Group Art Unit

3634

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three⁽³⁾ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 2/26/03
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-20, 22-24, 26-37, 39, 49-62 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1-20, 22-24, 26-37, 39, 49-53, 57-62 is/are allowed.
- ☒ Claim(s) 54, 55 is/are rejected.
- ☒ Claim(s) 56 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 3634

1. If additional defects or errors are corrected in the reissue after the filing of the application and the original reissue oath or declaration, a supplemental reissue oath/declaration must be filed, unless all additional errors corrected are spelling, grammar, typographical, editorial or clerical errors which are not errors under 35 U.S.C. 251 (see MPEP § 1402). In other words, a supplemental oath/declaration is required where any "error" under 35 U.S.C. 251 has been corrected and the error was not identified in the original reissue oath/declaration.

The supplemental reissue oath/declaration must state that every error which was corrected in the reissue application not covered by the prior oath(s)/declaration(s) submitted in the application arose without any deceptive intention on the part of the applicant.

2. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-20, 22-24, 26-37, 39, and 49-62 are rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above in paragraph 1.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C.

Art Unit: 3634

251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

3. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

4. The drawings are objected to under 37 CFR 1.83(a) because they fail to show:

- a) In claim 24, line 1 "threaded fasteners",
- b) In claim 30, line 2 "a substantially horizontal shelf",
- c) In claim 31, lines 1-2 "the shelf is adjustably mounted",
- d) In claim 32, lines 1-2 "the rack is narrower than the shelf",
- e) In claim 33, lines 1-2 "a clearance is defined between a lower surface of the shelf and an upper surface of the support assembly",
- f) In claim 34, line 3 "the clearance",
- g) In claim 35, line 1-2 "threaded fasteners",
- h) In claim 51, line 1 "fasteners",
- I) In claim 52, line 2 "apertures",

Art Unit: 3634

j) In claim 57, lines 9 and 10 "first and second apertures" (both occurrences), and in lines 17 and 18 "third and fourth apertures" (both occurrences),

k) In claim 58, lines 1 and 3 "the third and fourth apertures" (both occurrences),

l) In claim 59, lines 1-2 "the fasteners are threaded fasteners",

m) In claim 60, line 2 "the apertures",

n) In claim 61, line 2 "the apertures".

37 CFR 1.83(a) requires that the drawings in a nonprovisional application must show every feature of the invention specified in the claims. Any structural detail that is of sufficient importance to be described and claimed should be shown in the drawings. MPEP § 608.02(d). While the above noted features may be described in the specification, as applicant argues, that does not relieve him of the requirement to show those features in the drawings if those features are recited in the claims. Correction is required. Applicant is warned against the adding of new matter.

5. Claims 54 and 55 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed **subject matter surrendered in the application** for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472,

Art Unit: 3634

46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to **subject matter that applicants previously surrendered** during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent **was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered** in the application for the patent cannot be recaptured by the filing of the present reissue application.

In this regard, original patent claim 1 recites:

"In one of a cooler, visi-cooler, walk-in cooler and glass-door cooler having fixed or adjustable shelves, the improvement comprising;"

original patent claim 5 recites:

"wherein the framework comprises further rod-like members extending from one end at the stop to an opposite end that is rearward of a rearward most one of the at least one other rod-like member." ,

and original patent claim 14 recites:

"further comprising members on the front and other rod-like members for fixing the framework under another structure."

Art Unit: 3634

A review of the application file (09/015,595) for original patent No. 6,044,983, upon which this reissue application is based, reveals that original application claims 4, 8, and 17 were amended to overcome a prior art rejection (Office Action Paper No. 6, March 18, 1999), with the above three noted claim limitations making application claims 4, 8, and 17 allowable over the prior art of record. Original application claims 4, 8, and 17 subsequently issued as independent patent claims 1, 5, and 14, respectively. As a result, these omitted limitations relate to subject matter previously surrendered by applicants, and impermissible recapture exists. Thus, any claim in reissue must include at least one of these limitations. Regarding rejected claim 54 the term "rod-like" is not present in line 9 when referring to the "further members". And, rejected claim 55 includes none of the three noted limitations.

Applicant's remarks regarding the rejection of claims 54 and 55 under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter have been considered, however they are not deemed persuasive. In this regard, the limitation of "In one of a cooler, visi-cooler, walk-in cooler and glass-

Art Unit: 3634

door cooler having fixed or adjustable shelves, the improvement comprising;" was added to original claim 4 to overcome the prior art rejection of that claim. And, while it is true that original application claims 8 and 17 were indicated as containing allowable subject matter they were, none-the-less, amended to overcome a prior art rejection, in this case the prior art rejection of original application claim 4. The fact that the limitations of original application claim 4 were added to original application claims 8 and 17, rather than the converse, is of no moment. The result is the same, with the limitations of original application claims 8 and 17 clearly being the limitations making those amended claims allowable over the prior art.

6. Claims 1-20, 22-24, 26-37, 39, 49-53, and 57-62 are allowed.


7. Claim 56 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 3634

8. Any inquiry concerning this communication should be directed to Robert W. Gibson, Jr. at telephone number (703) 308-2168.

rwg

May 15, 2003


ROBERT W. GIBSON, JR.
PRIMARY EXAMINER
ART UNIT 3634